

REMARKS/ ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1-5, 7-9, 12, 14, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,999,997 (hereinafter "Pipes") in view of U.S. Patent 6,128,661 (hereinafter "Flanagin").

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant's independent claims 1, 12, and 17, include limitations that are not disclosed nor suggested by the Pipes or Flanagin references. As a result, Applicant's independent claims are patentable over the Pipes and Flanagin references.

In particular, Applicant's independent claims 1, 12, and 17, include the limitation, or a limitation similar thereto, of a housing to have an electronic device docked into a notebook computer. Pipes, however, only teaches docking a portable

computer into a server, rather than a notebook computer, as is claimed by applicant.

The Examiner states that one of ordinary skill in the art would have been motivated to replace the desktop disclosed in Pipes with a notebook computer because a notebook computer is more portable. However, to do so would destroy the intended function of Pipes.

If proposed modifications of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 Fed. 2d 810, 123 USPQ 349. (MPEP §2143.01).

The principle operation of Pipes is to provide a server that is able to dock a portable computer, so that the server would not have to have peripherals such a keyboard etc. Rather, a user could use the peripheral provided by the docked notebook and the processing power of the server docking the notebook.

Among the advantages of the invention are one or more of the following. A dedicated keyboard, mouse or display does not have to be purchased for the server. One portable computer may provide a keyboard, monitor, or mouse for any of several servers. (Col. 2, lines 7-11.)

As shown in FIGS. 1A and 1B, unlike a portable computer 200, a file server 100 does not typically require input/output (I/O) devices 230-232 (a monitor 231, a keyboard 230, and a mouse 232) that are typically part of the portable computer 200 because the server 100 normally does its work without the need for direct intervention between the server and the user. In the invention, when I/O devices are needed by the server 100, they can be provided from the portable computer 200 by docking it

(mechanically and electrically connecting it) to the server 100. Once docked, the portable computer 200 may operate in a run time mode which permits the server 100 to access and directly use the I/O devices 230-232 as if the I/O devices 230-232 were part of the server 100.

Thus, additional I/O devices do not have to be purchased specifically for the server 100, reducing cost. When not docked to the server 100, the portable computer 200 may be used as a workstation of a Local Area Network (LAN) or a Wide Area Network (WAN) serviced by the server 100 or as a stand-alone portable computer. (Col. 2, lines 35-55.)

Therefore, to modify the server of Pipes to be a notebook computer, as claimed by applicant, would change the principle operation of Pipes to provide a server computer not having to have a variety of peripherals.

Although Pipes does fortuitously mention the conflicting statement that the first computer may be a portable computer, the statement is conflicting with the overwhelming primary teachings of Pipes (to have the first computer be a server to dock a separate portable computer.) The test of obviousness is what the teaching of the reference would have suggested to one skilled in the art, and where there are conflicting teachings the examiner is to weight the power of each when considering the teachings to one skilled in the art. (*In re Young*, 927 F.2d 588, 18 USPQ 2d 1089 (Fed. Cir. 1991)).

As a result, applicant's independent claims are patentable over Pipes in view of Flanagan. Moreover, applicant's remaining claims depend from at least one of the independent claims, as discussed above, and therefore also include the

distinguishing limitation of the respective independent claim. The dependent claims are therefore also patentable over Tran in view of Kobayashi.

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 7/23/04


John P. Ward
Reg. No. 40,216

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300